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07768,105 07/30/91 NILSEN

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EXAMINER

BEHA JR, W

ART UNIT

PAPER NUMBER

2102

91

DATE MAILED:

06/29/92

CLE K. NILSEN  
CAESAR DRIVE, RR-5  
BARRINGTON, IL 60010

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

- ☒ This application has been examined ☐ Responsive to communication filed on \_\_\_\_\_ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), \_\_\_\_\_ days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

**Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

- ☒ Notice of References Cited by Examiner, PTO-892.
- ☐ Notice re Patent Drawing, PTO-948.
- ☐ Notice of Art Cited by Applicant, PTO-1449.
- ☐ Notice of Informal Patent Application, Form PTO-152.
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☐ \_\_\_\_\_

**Part II SUMMARY OF ACTION**

1. ☒ Claims 147-165 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2. ☒ Claims 139-144 have been cancelled.

3. ☐ Claims \_\_\_\_\_ are allowed.

4. ☒ Claims 147-165 are rejected.

5. ☐ Claims \_\_\_\_\_ are objected to.

6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

7. ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed on \_\_\_\_\_, has been ☐ approved. ☐ disapproved (see explanation).

12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received  
☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

**EXAMINER'S ACTION**

Serial No. 768,105

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Applicant's paper entitled "File Wrapper Continuation," filed September 30, 1991 states:

The original claims have been  
canceled and new claims  
145-162 are presented in a  
document attached hereto...

For purposes of this action, it is therefore assumed that said paper implicitly cancels all claims lower than claim 145.

In an amendment filed January 25, 1990, applicant attempted to add claims 145 and 146. Entry of those claims was denied. However, 37 CFR 1.126 requires that when claims are later added, they must be numbered by the applicant consecutively beginning with the number next following the highest numbered claim previously presented, whether entered or not. Accordingly, the new claims 145-162 (there are two claims numbered 162) of the File Wrapper Continuation have been renumbered sequentially claims 147-165. Applicant is advised to change his numbering accordingly.

This application filed under 37 C.F.R. § 1.62 lacks the necessary reference to the prior application. A statement reading "This is a continuation-in-part of application Serial No. 06/787,692, filed October 15, 1985" should be entered following the title of the invention or as the first sentence of the specification. Also, the present status of the parent application(s) should be included.

This is deemed to be a continuation-in-part rather than a

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continuation, because claims 151, 153, 158, 160, 163 and 164 add new matter to the application, which new matter has neither express nor inherent support in the parent application Ser. No. 06/787,692.

In the absence of the necessary reference to earlier applications, and also in some cases, because certain claims are not entitled to an earlier filing date because they add new matter not expressly or inherently disclosed in earlier applications, claims 147-165 are entitled to an earliest filing date of September 30, 1991.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 147-150, 152, 154-157, 159, 161, 162 and 165 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Nilssen 4,677,345.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which

the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 151, 153, 158, 160, 163 and 164 are rejected under 35 U.S.C. § 103 as being unpatentable over Nilssen 4,677,345.

The claims differ from the express and inherent teachings of Nilssen '345 by the specified claimed durations. But they are obvious to one of ordinary skill as being in a range of acceptable durations (but not necessarily inherent).

This rejection cannot be overcome by necessary reference to prior applications.

Claims 147-150, 155-157, 159, 161, 162 and 165 are rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 7 and 8 of prior U.S. Patent No. 4,677,345. This is a double patenting rejection.

These claims are drawn to the inherent function of the apparatus of claims 7 and 8 of Nilssen 4,677,345. Applicant cannot extend his monopoly of identical subject matter using this technique, because it is prohibited by 35 USC 101 allowing only one patent for one invention.

And if applicant can make a convincing case that the duration limitations of claims 151, 153, 158, 160, 163 and 164 are

inherent, then applicant is put on notice that these claims will be subject to the same double patenting rejection as the other claims above.

Claims 162-165 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are misdescriptive because the recitation of claim 165, lines 16 and 17 has no basis in a waveform that has *been* previously described as "a substantially square-wave output voltage" (claim 141) or similar words to that effect (claims 142-144).

Claim 150 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 150 includes an improper negative limitation, i.e., "without any intervening impedance means." The claim must describe what the structure is, not what it is not. Thus claim 150 falls short of 35 USC 112, para. 2.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that

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the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 147-151, 153 and 155-165 are rejected under 35 U.S.C. § 103 as being unpatentable over Walker in view of ~~P~~rintal.

Reference is made to the Board of Appeals decision (Paper No. 68, pages 6, line 11 to page 8, line 17), and to the Examiners Answer, mailed June 17, 1988, pages 3-5), for the underlying rationale.

New claims 147 et seq., broadly claim a DC source means, an inverter means and a gas discharge means, in combination. In paper No. 68, the board has decided that claims drawn to a DC source means and an inverter means, each means defined in more limiting terms than claims 147 et seq., are unpatentable over Walker and Printel considered together. It follows, that less limited DC source means and inverter means are unpatentable for the same reasons.

As to the addition of a specific lamp load to the combination, this has been taught by Walker col. 6, lines 54-58, all along.

As to the claimed inverter voltage AC waveform, these are the obvious result of combining Walker and Pintel.

Claim 152 is rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1 and 7 of prior U.S. Patent No. 5,047,690. This is a double patenting rejection.

Claim 152 is drawn to the same corresponding structure a claims 1 and 7 of Nilssen 5,047,690. The claimed inverter AC voltage of claim 152 (essentially trapezoidal) is deemed to be identical to the inverter AC voltage of patented claim 1 (squarewave), since in both instances they arise out of, and describe the same waveform (figure 3A).

Claims 152 and 154 are rejected under 35 U.S.C. § 103 as being unpatentable over Walker in view of Pintel as applied to claim 147 above, and further in view of Elms.

The claims further differ from claim 147 by calling for a lamp terminal connected to the power line (claim 152) and an inverter including two series connected transistors (claim 154). These differences are the natural result of 1) using a half bridge inverter and 2) providing for selective connection to 110 or 220V AC, as shown by Elms.

One uses a half bridge inverter over a double ended inverter to protect the transistors against excessive voltages. One uses a selective input to different sources to increase inverter utility. Thus these differences are obvious differences.

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Any inquiry concerning this communication should be directed to William H. Beha at telephone number (703) 308-1776.

*William H. Beha*

Beha/dc  
June 23, 1992

WILLIAM H. BEHA, JR.  
SENIOR EXAMINER  
GROUP ART UNIT 212